

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	Customer Number: 46320
	:	
Bradford FISHER, et al.	:	Confirmation Number: 9674
	:	
Application No.: 10/672,777	:	Group Art Unit: 2143
	:	
Filed: September 26, 2003	:	Examiner: K. Belani
	:	
Appeal No. 2009-006321	:	
	:	
For: REAL-TIME SLA IMPACT ANALYSIS	:	

**REQUEST FOR REHEARING**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated September 22, 2008 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of March 3, 2008, and in the Reply Brief of July 14, 2008. Appellants will specifically identify these particular points below.

**REMARKS**

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

On February 26, 2010, the precedential opinion of Ex parte Frye, Appeal 2009-006013, was issued by the Board of Patent Appeals and Interferences (BPAI). Referring to the first full paragraph on page 15 of Ex parte Frye, the following was stated:

Our decision is limited to the finding before us for review. The Board does not "allow" claims of an application and cannot direct an examiner to pass an application to issuance. Rather, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner").[footnote 2 omitted] (underline added)

The Honorable Board further went on to state within Ex parte Frye that:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. See Oetiker, 977 F.2d at 1445 ("In reviewing the examiner's

1 decision on appeal, the Board must necessarily weigh all of the evidence and  
2 argument.”) (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief  
3 must include “the contentions of appellant with respect to each ground of  
4 rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis  
5 therefor, with citations of the statutes, regulations, authorities, and parts of the  
6 record relied on”). Specifically, the Board reviews the particular finding(s)  
7 contested by an appellant anew in light of all the evidence and argument on that  
8 issue. (emphasis added)  
9

10 As discussed above, a decision of the BPAI is limited to the findings and conclusions  
11 made by the Examiner. Additionally, a complete *de novo* review is to be performed on all issues  
12 that are raised by Appellants without deference to the positions taken by the Examiner.  
13

#### 14 APPLICATION OF INCORRECT STANDARD OF REVIEW

15 Referring to the paragraph spanning pages 11 and 12 of the Decision, the Honorable  
16 Board asserted the following:

17 Appellants have the opportunity on appeal to the Board of Patent Appeals  
18 and Interferences (BPAI) to demonstrate error in the Examiner’s position. *See In*  
19 *re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d  
20 1350, 1355 (Fed. Cir. 1998)) ... Therefore, we look to the Appellants’ Briefs to  
21 show error in the proffered reasoned conclusions. *See Kahn*, 441 F.3d at 985-86.  
22 (emphasis added)  
23

24 The Honorable Board's case citation is misplaced. In re Kahn does not stand for the proposition  
25 that Appellants have the burden on Appeal to demonstrate or show Examiner error. Referring to  
26 the cited portion of the In re Kahn decision, the Federal Circuit stated that "we review the  
27 Board's underlying factual findings, including a finding of a motivation to combine, for  
28 substantial evidence." The Federal Circuit then laid out what is meant by substantial evidence  
29 after which the Federal Circuit block cited the following:

1 [t]o reject claims in an application under section 103, an examiner must show an  
2 un rebutted *prima facie* case of obviousness.... On appeal to the Board, an  
3 applicant can overcome a rejection by showing insufficient evidence of *prima*  
4 *facie* obviousness or by rebutting the *prima facie* case with evidence of secondary  
5 indicia of nonobviousness.  
6

7 Notably this passage only states that Appellants "can" overcome a rejection in a particular  
8 manner – not that Appellants are burdened to demonstrate or show Examiner error.  
9

10 Appellants' view of In re Kahn is supported by the precedential decision of Ex parte Frye,  
11 which was discussed above. As stated therein, Appellants identify the issues that are to be  
12 reviewed on Appeal. Then Board then reviews these issues *de novo* without deference to the  
13 positions taken by the Examiner. By requiring that Appellants demonstrate or show Examiner  
14 error, the Honorable Board has incorrectly given deference to the positions taken by the  
15 Examiner and incorrectly required that Appellants establish Examiner error.  
16

17 The correct standard of review entails that the Honorable Board consider all of the issues  
18 raised by Appellants. Once Appellants have identified these issues, the Honorable Board must  
19 ascertain whether the findings of facts at issue are supported by substantial evidence and also by  
20 the preponderance of the evidence. Employing the wrong standard of review is reversible error  
21 where the standard of review employed makes it more difficult for Appellants to overcome a  
22 rejection. See Price v. Symsek, 988 F.2d 1187, 1194-95, 26 USPQ2d 1031, 1036-37 (Fed. Cir.  
23 1993). By giving deference to the Examiner's positions and by burdening Appellants to produce  
24 evidence and/or arguments that are not required by law, the Honorable Board has made it more  
25 difficult for Appellants to overcome the pending rejection. In such a situation, the Honorable

Board's misapplication of the standard of review cannot be considered "harmless" and constitutes reversible legal error.

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OVERLOOKING APPELLANT'S ARGUMENTS

Referring to the first full paragraph on page 12 and the cited footnote 4, the Honorable Board asserted the following:

We also note that Appellants make numerous confusing and irrelevant arguments directed to the prosecution of their patent application preceding the last office action mailed on October 3, 2007 ("Final Office Action"). [FN 4]

[FN 4] Appellants make numerous arguments related to office actions preceding the Final Office Action. (App. Br. 5-18.) We remind Appellants that they currently appeal the Examiner's rejection of claims 1-11 in the Final Office Action. (App. Br. 2.) The rejections in the Final Office Action are the only rejections before the BPAI on appeal. Accordingly, the rejections made in the preceding office actions and any corresponding responses by Appellants are not before the BPAI, and we will not address any arguments related to prosecution preceding the Last Office Action. (emphasis added)

As to the Honorable Board's assertion that Appellants have made a numerous "confusing" arguments, Appellants note that the Appeal Brief was filed on March 3, 2008. On July 20, 2007, the Patent Office presented, for comments, Rules for Practice Before the Board of Patent Appeals and Interferences, 72 Fed. Reg. 41,472 (2007). Proposed rule 37 C.F.R. § 41.37(o) required that "[a]ny explanation must address all points made by the examiner with which the appellant disagrees and must identify where the argument was made in the first instance" (emphasis added). Thus, the format employed by Appellants in the Appeal Brief was consistent with the

manner of formatting in which the Patent Office, at the time, was proposing to require Appeal Briefs to follow.<sup>1</sup>

The Honorable Board's assertion that Appellants made "irrelevant arguments" is entirely inaccurate. Referring to the last full paragraph on page 5 of the Appeal Brief, Appellants noted the following:

Upon comparing the Examiner's statement of the rejection in the First Office Action dated May 24, 2007 (hereinafter the First Office Action) with the Examiner's statement of the rejection in the Second Office Action, with the exception of the "Response to Arguments" section found on pages 17-22 of the Second Office Action, Appellants have been unable to identify any substantive changes between the two Office Actions. Thus, specific portions of the First Office Action being referenced below have comparable portions within the Second Office Action.

As explicitly noted by Appellants, the Examiner's First and Second Office Actions were, in essence, identical in that the specific portions of the First Office Action being referenced in the Appeal Brief had comparable portions within the Second Office Action.<sup>2</sup> Since the Examiner had not substantively changed the statement of the rejection, from the First Office Action to the Second Office Action, Appellants arguments were (and are) still germane.

Since the Honorable Board has admitted that "we will not address any arguments related to prosecution preceding the Last Office Action" despite these arguments being germane to the Second (i.e., "Last") Office Action, the Honorable Board has failed to consider all of Appellants'

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<sup>1</sup> Subsequently, on June 10, 2008, the Patent Office issued Final Rules for Practice Before the Board of Patent Appeals and Interferences, 73 Fed. Reg. 32,937 (2008), in which proposed rule 37 C.F.R. § 41.37(o) required "an explanation must identify where the argument was made in the first instance."

<sup>2</sup> The Second and Final Office Action is the action from which appeal was taken.

1 arguments. Combining the Honorable Board's admitted failure to consider all of Appellants'  
2 arguments with the Honorable Board applying an incorrect standard of review to the issues  
3 raised by Appellants that the Honorable Board did consider, Appellants' position is that the  
4 present Decision is fatally deficient. Moreover, in analyzing the current Decision, Appellants  
5 cannot rely upon the Honorable Board maintaining the same positions in a subsequent Decision  
6 as the Honorable Board presented in the current Decision because of these errors. Thus,  
7 although Appellants will point out certain errors in the Honorable Board's current analysis,  
8 Appellants recognize that any subsequent Decision by the Board will necessarily be different and  
9 Appellants should be given the opportunity to address the Honorable Board's new analysis.

10  
11 NEW GROUNDS OF REJECTION

12 The Honorable Board's new findings and new analysis constitute new grounds of  
13 rejection. Although a new rejection is commonly thought as being a "new grounds of rejection,"  
14 a new rejection is not the only situation in which a designation of new grounds of rejection is  
15 appropriate.<sup>3</sup>

16  
17 Within In re Kumar,<sup>4</sup> an example of a "new grounds of rejection" was identified by the  
18 Federal Circuit. The patent application at issue within In re Kumar is U.S. Application No.  
19 09/136,483. On February 29, 2000, a Final Office Action was issued in which claims 1-3, 5-16,  
20 and 19-22 were rejected under 35 U.S.C. § 103 based upon Rostoker et al., U.S. Patent No.  
21 5,389,194 alone or in view of Ueda et al., U.S. Patent No. 5,697,992. On February 27, 2003, the  
22 Board of Patent Appeals & Interferences (hereinafter the BPAI) affirmed the Examiner's

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<sup>3</sup> Hyatt v. Dudas, 551 F.3d 1307, 1312–13, 89 USPQ2d 1465, 1468–69 (Fed. Cir. 2008) (in the context of "written description," rejecting the PTO's contention that "ground of rejection" is limited to "merely the statutory section").

<sup>4</sup> 418 F.3d 1361, 1365. (Fed. Cir. 2005).

1 rejection based upon findings of fact (i.e., calculations) that were not presented by the Examiner.

2 With regard to these new findings of fact, the Federal Circuit determined:

3           These calculations had not been made by the examiner, and according to  
4           the record were not presented during the argument of the appeal to the Board. The  
5           Board apparently made these calculations during its decision of the appeal. The  
6           Board included these calculations in an Appendix to its decision, holding that they  
7           support a *prima facie* case of obviousness and that Kumar's evidence had not  
8           rebutted the *prima facie* case.  
9

10           In addressing rebuttal evidence that was presented (and refused consideration) in  
11 response to the BPAI's findings, the Federal Circuit further stated:

12           The values identified by the Board's calculations were not contained in the  
13           prior art or any examination record, but appeared for the first time in the Board's  
14           opinion. Although the PTO argues that the calculations the Board included in its  
15           decision were not new evidence, but simply an additional explanation of the  
16           Board's decision, these values produced and relied on by the Board had not  
17           previously been identified by the examiner or the Board. Kumar was entitled to  
18           respond to these calculations, and the Board committed procedural error in  
19           refusing to consider the evidence proffered in response.  
20

21           The Federal Circuit concluded that "the Board's calculations and its decision based  
22 thereon constituted a new ground of rejection." Thus, the introduction of new findings, even  
23 though these findings related to a previously-presented rejection, constituted a new grounds of  
24 rejection.  
25

26           Referring In re DeBlauwe, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984), the Federal Circuit  
27 further stated "[w]here the board makes a decision advancing a position or rationale new to the



1 proceedings, an applicant must be afforded an opportunity to respond to that position or rationale  
2 by submission of contradicting evidence"). Referring to In re Ahlert, 424 F.2d 1088, 1098, 165  
3 USPQ 418, 421 (CCPA 1970), the Court stated "combining the disclosures of the references with  
4 the new facts judicially noticed, amounted to a new ground of rejection." Within In re Eynde,  
5 480 F.2d 1364, 1371, 178 USPQ 470, 475 (CCPA 1973), the Court stated that even though  
6 Board's new rationale was in response to arguments made in the Reply Brief, it was nonetheless  
7 deemed a "new ground."

8  
9 In response to the BPAI denying a request that the BPAI designate a rejection as "new"  
10 and allow new evidence to be introduced, within In re Ansel, 852, F.2d 1294 (Fed. Cir. 1988)  
11 (designated as an Unpublished Disposition), the Federal Circuit stated:

12 We cannot agree with the board that its reasoning does not represent a significant  
13 shift in the basic thrust of the rejection. Not only do the rejections at issue here  
14 represent different views of what the cited references teach, they also require the  
15 applicants to respond in quite different manners.

16  
17 In a situation very like the facts of present Application, the Court of Customs and Patent  
18 Appeals (i.e., the predecessor to the Federal Circuit), stated the following within In re Echerd,  
19 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973):

20 We find the new reliance by the board on Gouveia alone to be in effect a  
21 new ground of rejection. New portions of the reference are relied upon to support  
22 an entirely new theory ... [u]nder such circumstances, appellants should have  
23 been accorded an opportunity to present rebuttal evidence.

1           NEW GROUNDS OF REJECTION – FINDINGS OF FACT

2           Referring to the statement of the rejection on pages 3 and 4 of the Examiner's Answer,<sup>5</sup>  
3 the only passages within Bartz cited by the Examiner is column 9, line 30 through column 10,  
4 line 11. On page 18 of the Examiner's Answer, the Examiner newly cited column 11, lines 33-45  
5 of Bartz. Referring to pages 5-7 of the Decision, regarding Findings of Fact 1-3 as to Bartz, the  
6 Honorable Board newly cites to a multitude of passages with Bartz. For example, Finding of  
7 Fact 1 refers to column 2, lines 14-17; column 2, lines 19-21; column 2, lines 26-27; column 2,  
8 lines 28-34; and column 9, line 30 through column 12, line 8. Notably, most of these passages  
9 were not cited by the Examiner.

10  
11           Referring to Finding of Fact 2, the Honorable Board cites column 3, lines 7-48 and  
12 column 3, lines 20-27. However, neither of these passages were cited by the Examiner.  
13 Referring to Finding of Fact 3, the Honorable Board cites to certain previously cited passages  
14 within Bartz but also newly cites to column 10, lines 24-49; column 10, line 11 through column  
15 11, line 32, and column 11, line 46 through column 12, line 11; and column 13, lines 25-63. The  
16 Honorable Board's newly citing these passages within Bartz and reliance upon these passages in  
17 affirming the Examiner's rejections constitutes a new grounds of rejection.

18  
19  
20           OVERLOOKING APPELLANT'S ARGUMENTS

21           Referring to the first full paragraph on page 13 of the Examiner's Answer, the Honorable  
22 Board asserted the following:

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<sup>5</sup> See also pages 2-4 of the Second Office Action and pages 2-3 of the First Office Action.

1           The Examiner finds that the Bartz reference discloses the disputed features  
2           of an underlying resource and “at least one resource upon which the underlying  
3           resource depends,” in that Bartz describes Service Level Objectives (SLOs) for  
4           characteristics of a particular resource – for example, two distinct server resources  
5           (Server 1 and Server 2) *where the characteristics described in the SLOs affect*  
6           *one another, for example that the throughput of Server 1 (a storage server) may*  
7           *affect the response time of Server 2 (a web server) or vice versa. (Ans. 3-4, 18-*  
8           *19.)* The Examiner also finds that the Bartz reference discloses the disputed  
9           feature of “receiving an event,” as Bartz explicitly describes detecting a SLO  
10          violation, for example, throughput falling below a threshold. (Ans. 4, 19-20.)  
11          (underline in original; bolded and italics added).

12  
13       Referring to pages 8, lines 11-12 of the Appeal Brief, Appellants underlined a passage, similar to  
14       that bolded and italicized above, from page 18 of the Examiner's Answer. Subsequently, on page  
15       8, lines 18-23 of the Appeal Brief, Appellants argued the following:

16           Moreover, despite the Examiner's assertion, the Examiner's cited passage of  
17           column 9, line 30 through column 10, line 11) is completely silent as to why  
18           SLO1 or SLO2 went into non-compliance. The underlined portion of the above-  
19           reproduced passage is a factually-unsupported inherency argument that does not  
20           meet the requirements for establishing that a particular feature is inherently (i.e.,  
21           necessarily) disclosed by Bartz. (emphasis added)

22  
23       Thus, Appellants raised the issue as to whether Bartz teaches that "throughput of a resource such  
24       as a storage server will impact the response time of an underlying resource such as a web  
25       server," as alleged by the Examiner, or, as rephrased by the Honorable Board, "where the  
26       characteristics described in the SLOs affect one another, for example that the throughput of  
27       Server 1 (a storage server) may affect the response time of Server 2 (a web server) or vice versa."

1 As noted above, a complete *de novo* review is to be performed on all issues that are raised  
2 by Appellants without deference to the positions taken by the Examiner. Additionally, factual  
3 findings are reviewed to determine whether they are unsupported by substantial evidence. Thus,  
4 in order to affirm the Examiner's analysis, the Honorable Board must identify substantial  
5 evidence to support a factual finding that Bartz either explicitly or inherently teaches "throughput  
6 of a resource such as a storage server will impact the response time of an underlying resource  
7 such as a web server," which was alleged by the Examiner. However, neither the Examiner nor  
8 the Honorable Board has pointed to any substantial evidence to support this finding. Thus, on  
9 this basis alone, without considering any other issue, the Examiner's analysis fails.<sup>6</sup>

10  
11 NEW GROUNDS OF REJECTION – CLAIM CONSTRUCTION

12 Referring to the paragraph spanning pages 13 and 14 of the Decision, the Honorable  
13 Board presents claims constructions as to following claim language: "underlying resource," "at  
14 least one resource upon which the underlying resource depends," "resource," "receiving an  
15 event," and "event." However, none of these claim constructions were presented by the  
16 Examiner. Therefore, the Honorable Board has advanced positions and/or rationales new to the  
17 proceedings, and thus, designation of a new grounds of rejection is necessary.

18  
19  

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<sup>6</sup> Notwithstanding that there is no substantial evidence to support the Examiner's alleged finding of fact, a review of Fig. 6 of Bartz clearly shows that throughput (i.e., the top bar) has no apparent affect on response time. Whether SLO2 (i.e., response time) is violated is independent of whether SLO1 (i.e., throughput) is violated. For example, in 84, in which SLO1 is violated, SLO2 is not violated half of the time. Also, in 86, although SLO1 is violated SLO2 is not violated at all. On the contrary, Fig. 6 illustrates instances in which the SLO2 is violated without SLO1 being violated. Thus, one skilled in the art would not infer that SLO1 impacts SLO2 or vice versa.

1           NEW GROUNDS OF REJECTION -- MAIN

2           Referring to the paragraph spanning pages 16 and 17 of the Decision, the Honorable  
3 Board also newly presents claim constructions regarding the claimed "specific resource" and  
4 "another resource." Specifically, the Honorable Board asserted the following:

5                     Based on the record before us, we find no error in the Examiner's  
6 obviousness rejection of representative claim 1. We agree with the Examiner that  
7 the Main and Bartz references would have collectively taught or suggested the  
8 disputed limitations of representative claim 1. As with claim 11 *supra*, we begin  
9 our analysis by construing Appellants' disputed claim limitations, and we broadly  
10 but reasonably construe Appellants' recited resources – Appellants' "specific  
11 resource" and "another resource" – as meaning a source of something useful, such  
12 as a source of information or a service provider, or an asset, for example, a data  
13 processing job performed by a mainframe computer or a computing resource such  
14 as CPU time.

15  
16 Not only are these claim constructions new grounds of rejection, the full extent of these claim  
17 constructions are unsupported. Specifically, Appellants are entirely unclear how the Honorable  
18 Board came to the conclusion that "a data processing job" is an example of an asset. A data  
19 processing job is an activity to be performed (i.e., a task, such as billing and order entry) – not a  
20 resource.

21  
22           Referring to Finding of Fact 4 as to Main on page 7 of the Decision, the Honorable Board  
23 newly cites column 1, lines 30-33 for the proposition that "many jobs are dependent on the  
24 successful completion of previous jobs." The fact that a job may be dependent upon previous  
25 jobs does not mean that the previous jobs, themselves, are assets. These previous jobs may  
26 create assets with which may be used by a subsequent job, but the previous jobs themselves are  
27 not assets.

Referring to page 17 of the Decision, the Honorable Board asserts that data processing jobs are specific resources (i.e., "we find that Main teaches specific resources (data processing jobs)"). However, Appellants' review of the record finds no such assertion made by the Examiner. Instead, referring to page 20 of the Examiner's Answer, in the "Response to Arguments" section, the Examiner asserted "[e]ach of these mainframe computers includes resources such as a processor or CPU, memory, and disk storage." Referring to page 22 of the Examiner's Answer, also in the "Response to Arguments" section, the Examiner asserted "a specific resource (Mainframe computer in Main et al. and servers in Bartz et al. reference)." Thus, the Honorable Board's finding as to what constitutes a "resource" is entirely different than the analysis presented by the Examiner. Therefore, yet again, the Honorable Board has presented new grounds of rejection, which must be designated as such.

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NEW GROUNDS OF REJECTION/IMPROPER BURDEN SHIFTING

Referring to the paragraph spanning pages 19 and 20 of the Decision, the Honorable Board asserted the following:

Even if we assume, *arguendo*, that Appellants are correct, and the Examiner has failed to show that Bartz explicitly discloses that server 1 violating "SLO 1 affects how server 2 meets SLO 2" (Reply Br. 4), this does not amount to evidence (or even argument) that such a relationship is beyond the understanding or skill of one skilled in the art, i.e., that Bartz would not have taught or suggested such a relationship to a skilled artisan. See *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1327 (Fed. Cir. 2008); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (Relying on the common sense of those skilled in the art, as well as Leapfrog's failure to present evidence that the modification

1           was beyond the skill of those skilled in the art, the Federal Circuit found a  
2           proposed modification to the prior art obvious.)

3  
4   At the outset, Appellants note that this position and/or rationale for upholding the Examiner's  
5   obviousness rejection was never presented by the Examiner and is a position and/or rationale  
6   newly advanced by the Honorable Board to the proceedings. Thus, designation of a new grounds  
7   of rejection is necessary.

8  
9           The Honorable Board's analysis ignores the requirement that "rejections on obviousness  
10   grounds cannot be sustained by merely conclusory statements; instead there must be some  
11   articulated reasoning with some rational underpinning to support the legal conclusion of  
12   obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn,  
13   441 F.3d 977, 988 (Fed. Cir. 2006)). Instead, the Honorable Board improperly presumes that the  
14   rational underpinning has been presented and then improperly shifts the burden to Appellants to  
15   establish "such a relationship is beyond the understanding or skill of one skilled in the art." "In  
16   rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a  
17   *prima facie* case of obviousness." In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In  
18   re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). Only after the *prima facie* case of  
19   obviousness has been made does the burden shift to Appellant to establish non-obviousness. The  
20   Honorable Board's analysis consists of conclusory statements without a rational underpinning.  
21   Thus, not only has the Honorable Board presented a new grounds of rejection, this new grounds  
22   of rejection is not properly supported.

OVERLOOKING APPELLANT'S ARGUMENTS – CLAIM 4

Referring to page 15, lines 7-8 of the Appeal Brief and page 8, lines 2-4 of the Reply Brief, Appellants argued that among one of Barkan's failings is the failure to teach the claimed "plurality of SLAs." As noted above, a complete *de novo* review is to be performed on all issues that are raised by Appellants without deference to the positions taken by the Examiner. Additionally, factual findings are reviewed to determine whether they are unsupported by substantial evidence. The Honorable Board, however, has failed to indicate where the Examiner has presented substantial evidence to support the Examiner's finding that Barkan teaches the limitations at issue. On page 21 of the Decision, the Honorable Board refers to "an SLA Manager, an SLA DB (database), and an SLA Engine," but these do not teach a plurality of SLAs." These teachings could be said to inherently (i.e., necessarily) teach a single SLA but not a plurality of SLAs, as claimed.

On page 18, lines 2-24 of the Appeal Brief and on page 9, line 7-13 of the Reply Brief, Appellants identified the issue that the Examiner has failed to establish that Barkan teaches the claimed "a modeling and evaluation system communicatively coupled to said relationship database and said service level manager and programmed to perform a real-time SLA impact analysis based both upon resources directly implicated by said SLAs and also upon resources which are related to said resources directly implicated by said SLAs." Upon reviewing the Decision, it appears that the Honorable Board has improperly deferred to the Examiner's findings. As noted above, a complete *de novo* review is to be performed on all issues that are raised by Appellants without deference to the positions taken by the Examiner. Additionally, factual findings are reviewed to determine whether they are unsupported by substantial evidence.



1 The Honorable Board, however, has failed to indicate where the Examiner has presented  
2 substantial evidence to support the Examiner's finding that Barkan teaches the limitations at  
3 issue. For example, the limitations at issue refer to "a real-time SLA impact analysis," and since  
4 the cited teaches do not refer to a real-time SLA impact analysis, the Examiner is burdened to  
5 explain why these limitations are taught by the applied prior art. See 37 C.F.R. § 1.104(c); In re  
6 Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir.  
7 1984). However, this burden has not been met.

8  
9 For the reasons set forth in the Appeal Brief of March 3, 2008, and in the Reply Brief of  
10 July 14, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board  
11 to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 22, 2010

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CUSTOMER NUMBER 46320